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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,459	06/23/2003	David P. Paradis	727002001-3227	2650
26719	7590	05/05/2005	EXAMINER	
RIORDAN & MCKINZIE 300 SOUTH GRAND AVENUE 29TH FLOOR LOS ANGELES, CA 90071			MATZEK, MATTHEW D	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/602,459	<b>Applicant(s)</b> PARADIS ET AL.	
	<b>Examiner</b> Matthew D. Matzek	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 27-56, 58 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/23/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26 and 57, drawn to a fiber material, classified in class 428, subclass 85.
- II. Claims 27-56, drawn to a method of making a fiber material, classified in class 57, subclass 239.
- III. Claims 58-59, drawn to a fiber product, classified in class 442, subclass 59.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the article of Group I may be made by drawing the first and second fibers next to one another at the same time negating the step of blending the two fibers together.

2. Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a yarn for an article of clothing and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant

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should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to a method to make a fiber and a carpet article.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Sandra Thompson on 4/18/2005 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-26 and 57. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-56 and 58-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-26 and 57 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A second luster component, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). At least a second luster component must be disclosed in order for one of ordinary skill in the art to be enabled to create the instantly claimed article.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The fiber material of instant claim 1 comprises binder fibers, however claims 7-10 recite that fiber material of claim 1 comprises a percentage of the binder fibers. This does not make sense to Examiner. Examiner takes the position that the binder fibers comprise a percentage of the fiber material not the converse.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tung et al. (US Patent 5,284,009) in view of Kobsa et al. (US Patent 4,559,196) and in further view of Meelheim (US Patent 3,376,249).

11. Tung et al. disclose a fiber blend for improved carpet texture retention (title). The applied patent teaches an invention of a ply-twisted yarn comprising fiber blends of a base fiber a non-melt compatible polyolefin fiber (Abstract). The base fiber may be polyamides, polyesters, or fiber mixtures thereof (Abstract). The base fiber preferably has a denier of about 6 to 25, and the polyolefin fiber has a denier of about 3 to 25 (col. 2, lines 55-62). The binder fibers may be bicomponent fibers in which one component of the fiber melts and becomes adhesive at a lower temperature than the other component in the fiber (col. 2, lines 22-28). The component fibers may contain delustrants. The applied patent is silent as to using two different delustrants.

12. Kobsa et al. disclose a process for improving the dyeability of nylon carpet fiber. The nylon carper fibers of the applied invention are prepared from random copolymers of nylon 66 and nylon 6 (Abstract). Delustrants for use in the process taught include polyethylene oxide or titanium dioxide (col. 3, line 37-47). Example 1 uses 0.3% TiO<sub>2</sub> for delustrant (col. 4, lines 29-32). Example 5 uses 0.04% TiO<sub>2</sub> for delustrant (col. 8, lines 57-60). The TiO<sub>2</sub> of examples 1 and 5 may be used as either the first or second luster component.

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13. It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the invention of Tung et al. with the delustrants and disclosed levels provided by Kobsa et al. The skilled artisan would have been motivated by the desire to create a delustered carpet with texture retention and novel luster and friction properties.

14. Claims 11-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tung et al. (US Patent 5,284,009) in view of Kobsa et al. (US Patent 4,559,196) and in further view of Meelheim (US Patent 3,376,249). The inventions of Tung et al. and Kobsa et al. have been previously disclosed, but are silent as using two different delustrants in the same article. The use of two different delustrants would meet the instant claim limitation that the first fiber comprises a different delustrant than the second fiber.

15. Meelheim teaches a process of making improved textile products such as yarns, filaments, and fibers possessing novel luster and friction properties (Abstract). Meelheim discloses that two different delustrants, titanium dioxide may be used with kaolinite to achieve a wide variety of combinations of surface luster and opacity (col. 2, lines 21-27).

16. It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the invention of Tung et al. with the delustrants provided for by Meelheim at the disclosed levels provided by Kobsa et al. The skilled artisan would have been motivated by the desire to create a delustered carpet with texture retention and novel luster and friction properties.

17. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tung et al. (US Patent 5,284,009) in view of Hayes (US Patent 5,082,720) and in further view of Lofquist (US Patent 5,478,624). The invention of Tung et al. has been previously disclosed, but is silent as to the nature of the bi-component binder fiber.

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18. Hayes discloses a melt-bondable, bicomponent fiber suitable for use in nonwoven articles (Abstract). Polymers suitable for the first component include nylon and polyolefins (col. 3, lines 56-60). Polymers suitable for the second component include polyolefins and polyamides (col. 4, lines 60-62). Nylon is a polyamide.

19. Lofquist teaches a synthetic yarn made from a blend of base fibers consisting of polyester, nylon 6 and nylon 6, 6 (col. 1, lines 40-45). A copolyamide binder fiber comprising of the copolyamides of the 6/66/12 type is also disclosed (col. 1, lines 46-49).

20. It would have been obvious to one of ordinary skill in the art to have made the invention of Tung et al. with the bicomponent binder fiber of Hayes using the nylons of Lofquist. The skilled artisan would have been motivated to use the binder fiber of Hayes as it is a bicomponent binder fiber comprising polyolefin as disclosed by Tung et al. The skilled artisan would have used the nylons of Lofquist in the binder fiber of Hayes as both teachings are directed to the use of nylons for binder fiber construction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdm

*MDM*

*Elizabeth M. Cole*  
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PRIMARY EXAMINER